

REMARKS

Applicants submit this Amendment After Final in reply to the Final Office Action dated August 7, 2003.

In this Amendment, Applicants have cancelled claim 3, without prejudice or disclaimer, and rewritten claim 1 to include the subject matter of claim 3. Claim 1 is the sole non-withdrawn independent claim.

Before entry of this Amendment After Final, claims 1-9 were pending in this application, with claims 6-8 having been withdrawn from consideration. After entry of this Amendment After Final, claims 1-2 and 4-9 will be pending in this application, with claims 6-8 still being withdrawn from consideration.

The originally-filed specification, claims, abstract, and drawings fully support the subject matter of rewritten claim 1. No new matter was introduced.

In the Office Action, the Examiner rejected claims 1 and 3-5 under 35 U.S.C. §102(b) as being anticipated by Meyers (U.S. Patent No. 5,543,966). Applicants respectfully traverse this rejection.

Meyers does not disclose or suggest the invention claimed in independent claim 1. Meyers, for example, fails to disclose the claimed second edge portion positioned at a partition line between a first die and a second die and/or fails to disclose the claimed flange surface. On page 3 of the Office Action, the Examiner asserted that "Meyer discloses that the first edge portion and the second edge portion of the flange, i.e. the upper and lower joined edges of S1 and S2, are both positioned at the partition line between the first die and the second die." Contrary to the Examiner's statement, the surfaces S1 and S2 cannot both be at the partition line if the lens includes a flange

surface parallel to the optical axis. The Examiner relies on Figure 2 of Meyers as showing a flange surface parallel to the optical axis, but that surface separates the surfaces S1 and S2. Figure 24 of Meyers, in contrast to Figure 2, fails to disclose the flange surface. Thus, at the least, Meyers either fails to disclose the claimed parallel flange surface or fails to disclose the claimed position of the partition line.

The Examiner then asserts on page 3 of the Office Action "Meyer fails to mention" that "the mold with the diffractive relief pattern is fixed and does not move during processing." In response, Applicants submit herewith a Declaration from Hiroyuki Hattori, one of the named inventors in this application. The Declaration sets forth the differences between Meyers and the claimed invention, and also sets forth an explanation of the molding process in Meyers. As depicted in Figs. A1-A4 of the declaration, in the molding process according to Meyers, the die separation first occurs from the surface 40 (S2) on which a diffractive structure is formed. Accordingly, in Meyers, a vertical displacement of the die when the first die and the second die part might deform the diffractive surface. Consequently, the present invention is not anticipated by Meyers, and Applicants respectfully request the withdrawal of the rejection.

In the Final Office Action, the Examiner rejected claim 2 under 35 U.S.C. §103(a) as being unpatentable over Meyers in view of Maruyama (U.S. Patent No. 5,978,140), and rejected claims 1, 3-5, and 9 under 35 U.S.C. §103(a) as being unpatentable over Nisper et al. (U.S. Patent No. 5,538,674) ("Nisper") in view of Ueda et al. (U.S. Patent No. 6,215,591) ("Ueda"). Applicants respectfully traverse these rejections.

With regard to the rejection of claim 2 as being unpatentable over Meyers in view of Maruyama, Applicants assert that Maruyama does not remedy at least the deficiencies of Meyers as set forth above with respect to the §102(b) rejection, and the Examiner does not assert otherwise in the Final Office Action. Accordingly, because the Examiner has not provided a *prima facie* case of obviousness, as the Examiner has not shown how Meyers in combination with Maruyama teaches or suggests every aspect of the claimed invention, Applicants respectfully request withdrawal of the rejection.

With regard to the rejection of claim 1, 3-5, and 9 as being unpatentable Nisper in view of Ueda, Applicants assert that the Examiner has not provided a proper motivation to set forth a proper *prima facie* case of obviousness, and in fact, Applicants assert that Nisper and Ueda teach against such a combination of references. The Examiner asserts on pages 3-4 of the Final Office Action that “[b]oth Nisper et al. and Ueda et al. disclose molding techniques for manufacturing the optical elements.” However, Ueda discloses a **press forming** technique, as shown in Figs. 5A and 5B, in which the upper die 30 is moved downward so as to press the glass 20. During this press forming process, an excess amount of the glass spills from the hollow portion into a peripheral space between opposite surfaces of the upper and lower dies as shown in Fig. 5B. In contrast, in the molding process of Nisper, at least two molding dies 504 and 506 are jointed such that opposite surfaces of the two molding dies are brought into contact with each other so as to avoid the leakage of molding resin (molding material) through the jointed surfaces. An injection port 510 is provided only at a point on the circumferential line of the partition line so that the molding resin is introduced in the hollow portion only

through the injection port. (Fig. 5; col. 7, lines 30-46). Accordingly, one could not combine Nisper in view of Ueda, where the combination would require the spilling of excess glass in Ueda into a peripheral space, even though Nisper does not provide for, and in fact teaches against, providing such a space. Accordingly, because Nisper and Ueda teach against the cited combination, a proper case of *prima facie* obviousness cannot be made, and thus Applicants respectfully request withdrawal of the rejection.

Applicants further submit that claims 2, 4-5, and 9 depend from independent claim 1, and are therefore allowable for at least the same reasons that independent claim 1 is allowable. In addition, at least some of the dependent claims recite unique combinations that are neither taught nor suggested by Meyers, Maruyama, Nisper, Ueda, or the cited art, and therefore at least some also are separately patentable.

Applicants respectfully request that this Amendment After Final under 37 C.F.R. § 1.116 be entered by the Examiner, placing claims 1-2, 4-5, and 9 in condition for allowance. Applicants submit that the proposed amendment of claim 1 does not raise new issues or necessitate the undertaking of any additional search of the art by the Examiner, since amended claim 1 is simply original claim 3 rewritten into independent form. Therefore, this Amendment should allow for immediate action by the Examiner.

Furthermore, Applicants respectfully point out that the final action by the Examiner presented some new arguments as to the application of the art against Applicants' invention. It is respectfully submitted that entering the Amendment would allow the Applicants to reply to the final rejections and place the application in condition for allowance.

Finally, Applicants submit that the entry of the amendment would place the application in better form for appeal, should the Examiner dispute the patentability of the pending claims.

In view of the foregoing remarks, Applicants submit that this claimed invention, as amended, is neither anticipated nor rendered obvious in view of the prior art references cited against this application. Applicants therefore request the entry of this Amendment, the Examiner's reconsideration and reexamination of the application, and the timely allowance of the pending claims.

The Office Action contains characterizations of the claims and the related art with which Applicants do not necessarily agree. Unless expressly noted otherwise, Applicants decline to subscribe to any statement or characterization in the Office Action.

In discussing the specification, claims, abstract, and drawings in this Amendment After Final, it is to be understood that Applicants are in no way intending to limit the scope of the claims to any exemplary embodiments described in the specification or abstract and/or shown in the drawings. Rather, Applicants are entitled to have the claims interpreted broadly, to the maximum extent permitted by statute, regulation, and applicable case law.

FINNEGAN
HENDERSON
FARABOW
GARRETT &
DUNNER LLP

1300 I Street, NW
Washington, DC 20005
202.408.4000
Fax 202.408.4400
www.finnegan.com

Please grant any extensions of time required to enter this response and charge
any additional required fees to our Deposit Account No. 06-0916.

Respectfully submitted,

FINNEGAN, HENDERSON, FARABOW,
GARRETT & DUNNER, L.L.P.

Dated: October 2, 2003

By: 

Michael W. Kim
Reg. No. 51,880

FINNEGAN
HENDERSON
FARABOW
GARRETT &
DUNNER LLP

1300 I Street, NW
Washington, DC 20005
202.408.4000
Fax 202.408.4400
www.finnegan.com